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| 09/913,744 | 01/10/2002 | Valery Poulbot | A34526-PCT | 3821 |
| 21003 | 7590 | 12/08/2003 | EXAMINER | |
| BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | MAKI, STEVEN D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1733 | |
| DATE MAILED: 12/08/2003 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,744

Applicant(s)

POULBOT, VALERY

Examiner

Steven D. Maki

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4-13 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1) Claims 4-13 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 4-13 have not been further treated on the merits.

2) The disclosure is objected to because of the following informalities:

- the disclosure describes "[sic]" (see bottom of page 12 and top of page 13).

Appropriate correction is required.

3) The drawings are objected to because figure 1b does not show "10c". In figure 1b, it is suggested to change "10" to --10c--. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5) Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1: It is unclear if the description of "base" (a term of art in the tire industry) requires a "cap". The scope and meaning of "it contains on its circumference" is ambiguous. What is it? Which location is required by "on its circumference"? In claim 1, the following changes are suggested: (1) on lines 2-3, change "having a base of" to --comprising--; (2) on lines 3-4 delete --it contains on its circumference--; and (3) after "sidewalls (4, 104, and 5, 105)" insert --is arranged in said tread--.

Claim 2 is indefinite because line 3 describes "[illegible handwriting]".

As to claims 2 and 3, the scope and meaning of the layer "... appreciably joins the said sidewalls (4 and 5), so that it is interrupted opposite at least one of them" (claim 2, emphasis added) and "...appreciably joins said sidewalls (4 and 5), so that it is interrupted opposite said radially inner and outer faces) (claim 2, emphasis added). The description of "joins" seems inconsistent with the description of "interrupted". Also, the difference between "interrupted opposite at least one of them" and " interrupted opposite said radially inner and outer faces" is unclear.

6) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Fielding

7) **Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Fielding (US 2342576).**

The claimed tread reads on the figure 5 embodiment in which a conductive layer 5 is arranged between an upper layer of non-conducting / high resistivity material and a lower layer of non-conducting / high resistivity material. The conductive layer joins "sidewalls" as claimed. See figure 5.

Japan '415

8) **Claim 1 are rejected under 35 U.S.C. 102(a) as being anticipated by Japan '415 (JP 11-227415).**

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Japan '415 discloses a tread comprising insulating material (silica reinforced rubber) 1 and conductive rubber 2.

In claim 1, the claimed tread reads on the tread shown in figure 2 or the tread shown in figure 3. The claimed at least one circumferentially extending conductive layer reads on one of the conductive layers extending from one side face of the tread to the other side face of the tread (e.g. a "horizontally extending layer" of the mesh defined by the conductive material).

9) **Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan '415 (JP 11-227415) in view of Aoki (US 5397616) or Europe '229 (EP 732229).**

As to claims 2 and 3, it would have been obvious to mold the multilayer tread of Japan '415 such that the claimed "interruptions" are provided in view of (a) Aoki's suggestion to mold circumferential grooves in a tread such that the lower tread layer is exposed for the benefit of preventing cracks the bottoms of the grooves or (b) Europe '229's suggestion to form circumferential grooves in a tread having a conductive layer and a silica layer.

Verbrugge

10) **Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Verbrugge (WO 98/38050) in view of Great Britain '757 (GB 544757) and optionally Aoki (US 5397616) or Europe '229 (EP 732229).**

Verbrugge, directed to an antistatic tread, discloses a tread having an insulating layer (silica reinforced layer) 8 and an insulating layer (silica reinforced layer) 9. A conducting insert 11 extends through the layer 8 and a conducting insert 12 extends through the layer 9. Verbrugge does not recite providing a conducting layer between the layers 8 and 9 so as to extend from one side face of the tread to another side face of the tread. However, it would have been obvious to one of ordinary skill in the art to coat the surfaces of the upper and lower layers of Verbrugge's tread with conducting rubber cement so that a conducting layer is located between the upper and lower layers of the tread and joins side faces ("sidewalls") of the layers of the tread in order to further improve static discharge since (a) Verbrugge's tread comprises two insulating layers and (b) Great Britain '757, also directed to an antistatic tire, suggests coating the upper surface of an insulating tread layer, the lower surface of the insulating tread and the splice of the insulating tread in order to improve static discharge (page 3 lines 116-121) and optionally (c) Aoki or Europe '229 suggest providing a tread having two layers with side faces so that the tread may be applied over the sidewall. Hence, Great Britain '757 provides ample motivation (improve conductivity for improved static discharge) to coat the surfaces of each electrically insulating layer of Verbrugge. Aoki / Europe '229 add

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to the disclosure of Verbrugge by more clearly showing the side faces of a two layer tread.

As to claims 2 and 3, it would have been obvious to mold the multilayer tread of Verbrugge such that the claimed "interruptions" are provided in view of (a) Aoki's suggestion to mold circumferential grooves in a tread such that the lower tread layer is exposed for the benefit of preventing cracks the bottoms of the grooves or (b) Europe '229's suggestion to form circumferential grooves in a tread having a conductive layer and a silica layer.

11) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12) Claims 1-3 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of copending Application No. 10/135692. Although the conflicting claims are not identical, they are not patentably distinct from each other because the process of claims 1-3 in copending 10/135692 provides the tread in claims 1-3 of this application.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

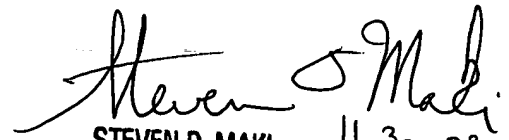
Remarks

- 13) The remaining references are of interest.
- 14) No claim is allowed.
- 15) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven D. Maki whose telephone number is 703-308-2068 until Dec. 18, 2003 and (571) 272-1221 after Dec. 18, 2003. The examiner can normally be reached on Mon. - Fri. 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (703) 308-3853. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Steven D. Maki
November 30, 2003


STEVEN D. MAKI
PRIMARY EXAMINER
~~GROUP 1300~~
AU 1733
11-30-03